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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,074

07/07/2003

Ronald R. Bartman

1005 - U.S.

6371

7590

09/26/2006

James G. Staples
586 Ingleside Park
Evanston, IL 60201

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,074

Applicant(s)

BARTMAN ET AL.

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 17-20 is/are rejected.
- 7) ☒ Claim(s) 5-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-6,8-14 and 17-20 in the reply filed on 07/10/06 is acknowledged. The traversal is on the ground(s) that the restriction is not pertinent because the amendments to the claims submitted 07/20/05 are directed to the same invention presented in the claims prior to the First Official Action. This is not found persuasive because although not normal, but as stated by the applicant and supported by 37CFR 1.142 (a), "a restriction may be made at any time before final action".

The requirement is still deemed proper and is therefore made FINAL.

Claims 15 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected fastening means, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/10/06.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no support in the specification for the "interior hidden surface".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the rear" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the visible surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the exterior viewable surface" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

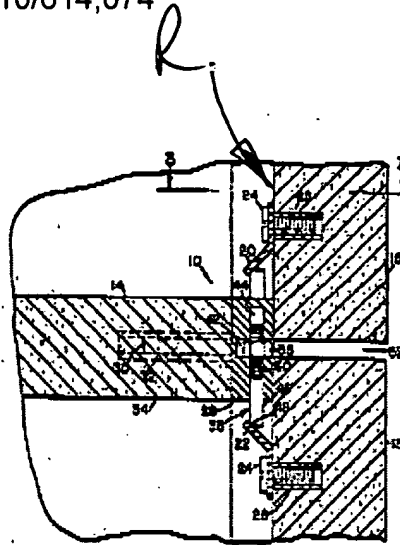
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,644,711 to EICKHOF. EICKHOF discloses a system for securing a plurality of visible facing objects (16,18) of stone, column 1, lines 8-11, having an interior hidden surface (R) on a rear thereof, a rigid and stationary supporting structure (14) there

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behind, and fastening means (10) located entirely below the upper edge of the visible facing object (16,18) such that the fastening means (10) is indistinguishable from a very short distance away. Because the fastening means (10) is disposed behind the panels, the fastening means are inherently vandal proof. Regarding claim 2, the fastening means (10) have a portion (38) which is visible through (52) only a short distance away and is inherently activatable only by non-standard tools (50). In reference to claims 3 and 4, no portion of the fastening means (10) extends outwardly from the exterior surface of the visible facing object (16,18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,638,618 to IESAKA et al. IESAKA et al. discloses a method of locating a visible facing stone, column 2, lines 36-41, object (2) including the steps of providing fastening means (18) having an access aperture (4,5) extending through to the visible face of the object (2); and securing the object (2) by operation of a tool, column 3, lines 40-44, inserted into the access aperture (4,5) and engaging the fastening means (18). IESAKA et al. discloses the basic claimed method except for explicitly detailing that his access apertures are indistinguishable from a few feet away. It would have been obvious to one having ordinary skill in the art at the time the invention was made that selection of an access aperture that is visible distinguishable or not is a design choice suitable for the use intended. Whether the aperture is able to be distinguished a few feet therefrom depends upon the actual size of the access aperture and the ability of the person's sight. For instance, if the aperture was relatively small, a person having good eyesight might be able to still see the aperture; however, a person with bad eyesight and possibly in need of glasses to see, might not be able to see the same size aperture. Regarding claim 18, IESAK et al. is silent with regards to the selection of the diameter of

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the tool end. It too would have been obvious to one having ordinary skill in the art at the time the invention was made to select a tool diameter according to the size of the aperture that the tools is required to fit within. In reference to claim 19, IESAKA et al. further discloses the step of snugly securing the object (2); thereafter, disassembling the object (2), column 1, line 50; and thereafter, tightly securing the object (2) to a support structure (9). Regarding claim 20, the steps of snugly securing only once and tightly securing thereafter, are obvious matter of design choices. It is very well known in the art that most fastening methods are slightly fastening the device and then tighten more securely. This procedure is known in the art for ensuring proper placement and positioning of objects before final installation.

Allowable Subject Matter

Claims 5-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yvonne M. Horton
Examiner
Art Unit 3635

YMH
09/20/06